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EXAMINER

ROSENBERG, LAURA B

ART UNIT PAPER NUMBER

3616

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/774,351

Applicant(s)

DODGE, DAVID

Examiner

Laura B Rosenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3,4,7,8,10-13,15,16 and 19-44 is/are pending in the application.
- 4a) Of the above claim(s) 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,4,7,8,15,16,19-34 and 37-44 is/are rejected.
- 7) ☒ Claim(s) 35 and 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 13 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This office action is in response to the amendment filed on June 13, 2003, in which claims 1, 2, 5, 6, 9, 14, 17, and 18 were canceled, claims 3, 7, 8, 15, 19, and 20 were amended, and claims 21-44 were added.

### ***Drawings***

2. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on June 13, 2003 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

3. The Patent and Trademark Office no longer makes drawing changes. See 1017 O.G. 4. It is applicant's responsibility to ensure that the drawings are corrected. Corrections must be made in accordance with the instructions below.

### **INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

#### **Replacement Drawing Sheets**

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

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Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

### **Annotated Drawing Sheets**

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheets must be clearly labeled as "Annotated Marked-up Drawings" and accompany the replacement sheets.

### **Timing of Corrections**

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

### ***Specification***

4. The substitute specification filed June 13, 2003 has not been entered in its entirety because it does not conform to 37 CFR 1.125(b) and (c) because: new matter is presented in lines 7-11 of paragraph 0043. Specifically, the new matter includes the symmetrical and asymmetrical features of the cams.

### ***Claim Objections***

5. Claims 7, 8, 23, 24, 31, and 32 are objected to because of the following informalities: "comprise" should be --comprises-- (line 2). Claim 40 is objected to

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because of the following informalities: "aroung" should be --around-- (line 3).

Appropriate correction is required.

6. Claims 10-13 are objected to because they depend from a canceled claim.

Further, since claims 10-13 are drawn to a non-elected species, no prior art rejection has been applied to these claims. The examiner recommends canceling claims 10-13.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 25, 26, 29, 30, 33, 34, 37, and 38 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the specification as originally filed does not support the following subject matter included in the newly added claims: the force required to operate the first cam being different <sup>from</sup> ~~to~~ the force required to operate the second cam (claims 25, 26, 33, 34); the first cam surface being symmetric or asymmetric to the second cam surface (claims 29, 30, 37, 38). Thus, due to the new matter in claims 25, 26, 29, 30, 33, 34, 37, and 38, these claims have not been further treated on the merits.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 3, 4, 7, 8, 21-30, and 39-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3 recites the limitation "the heel holding means" in line 11; claim 39 recites the limitation "said ski" in line 6; claim 43 recites the limitation "said boot holding surface" in line 9. There is insufficient antecedent basis for these limitations in the claims.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Korger (3,937,480). In regards to claim 39, Korger discloses a ski binding comprising a rigid static base plate (#12), a top plate (#4) pivotally attached to the base plate (via #6, 7), toe holding means (#2) mounted on the top plate, heel holding means (#3) mounted on the top plate, means to mount the base plate on a ski (#5) near a longitudinal center of the base plate (best seen in figure 1), and first pivot means (#6, 7) located between the center and the toe holding means adapted to allow the top plate to pivot around the first

pivot means. Korger does not disclose the toe holding means being pivotally connected to the top plate.

13. Claim 43 is rejected under 35 U.S.C. 102(b) as being anticipated by Perryman (3,764,155). In regards to claim 43, Perryman discloses a binding for mounting a ski boot to a ski (#11), the binding comprising a plate (#12) over which the ski boot may be placed, first pivot means (#13) for pivotally attaching the plate to the ski, toe holding means (#45) having a toe holding surface (best seen in figures 1, 2), and second pivot means to pivotally attach the toe holding means to the plate, wherein the second pivot means are located at a boot holding surface (best seen in figure 2).

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 4, 7, 8, 15, 16, 19, 20, 23, 24, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korger (3,937,480) in view of Perryman (3,764,155). In regards to claims 3 and 15, Korger discloses a ski binding for use with a ski (#5) comprising a static plate (#12) capable of being attached to the ski, a top plate (#4) pivotally attached to the static plate (via #6, 7), biasing means (#15, 16, 20, 21) for biasing the top plate towards a predetermined position, and a toe holding means (#2)

connected to the top plate. Korger does not disclose the toe holding means being pivotally connected to the top plate. Perryman teaches a binding for mounting a ski boot to a ski (#11), the binding comprising a plate (#12) pivotally attached to the ski (via pivot means #13), and toe holding means (#45) pivotally connected on the plate so that lateral force applied to the toe holding means is transferred to the plate, having toe release means which will release when the toe holding means pivots (best seen in figure 2) and simultaneously pivots a heel holding means (#18; column 3, lines 48-50). It would have been obvious to one skilled in the art at the time that the invention was made to modify the ski binding of Korger such that it comprised a pivoting feature and heel holding means as claimed in view of the teachings of Perryman so as to release the ski boot before damage occurs when undergoing excessive torsional moments (Perryman: column 1, lines 23-29).

In regards to claims 4 and 16, Korger discloses the base plate (#12) attached to the ski (#5) in a central portion of the base plate (best seen in figure 1).

In regards to claims 7, 8, 19, 20, 23, 24, 31, and 32, Korger discloses the biasing means comprising a first cam (#15, 16) and a second cam (#20, 21).

16. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korger (3,937,480) in view of Perryman (3,764,155), further in view of Horn (5,040,819). In regards to claim 21, Korger discloses heel holding means (#3) connected on the top plate (#4). Korger does not disclose heel holding means pivotally connected on the top plate. Horn teaches a ski binding with heel holding means (#8)



pivotally connected on a top plate (#1), the top plate being pivotally connected to a ski (#2), so that a lateral force applied to the heel holding means is transferred to the top plate, which will cause the heel holding means to pivot (via #42). It would have been obvious to one skilled in the art at the time that the invention was made to modify the ski binding of Korger such that it comprised a pivotally connected heel holding means as claimed in view of the teachings of Horn so as to pivot in the event of a backward fall or when an undesirable force is encountered (Horn: column 3, lines 42-50).

In regards to claim 22, Korger discloses the base plate (#12) attached to the ski (#5) in a central portion of the base plate (best seen in figure 1).

17. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Perryman (3,764,155) in view of Horn (5,040,819). In regards to claim 44, Perryman discloses a heel holding means (#18) attached to the plate (#12). Perryman does not disclose a third pivot means to pivotally attach the heel holding means on the plate. Horn teaches a heel holding means (#8) and pivot (#42) to pivotally attach the heel holding means on a plate. It would have been obvious to one skilled in the art at the time that the invention was made to modify the ski binding of Perryman such that it comprised a pivotal attachment for the heel holding means as claimed in view of the teachings of Horn so as to pivot in the event of a backward fall or when an undesirable force is encountered (Horn: column 3, lines 42-50).

***Response to Amendment***

18. The amendment filed June 13, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the symmetrical and asymmetrical features of the cams (lines 7-11 of paragraph 0043). Applicant is required to cancel the new matter in the reply to this Office Action.

***Allowable Subject Matter***

19. Claims 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. Claims 27, 28, and 40-42 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

21. Applicant's arguments with respect to claims 3, 4, 7, 8, 15, 16, and 19-44 have been considered but are moot in view of the new ground(s) of rejection. In addition, the examiner notes that the terms "attached" and "connected" do not require that an element be directly attached or connected to another element, but only that at least an indirect attachment connection is evident.

**Conclusion**

22. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schmidt discloses a ski binding including a top plate pivotally mounted on a base plate.

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura B Rosenberg whose telephone number is (703) 305-3135. The examiner can normally be reached on Monday-Friday 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Dickson can be reached on (703) 308-2089. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

*Lama B. Rosy*

LBR

*Paul N. Dickson* 9/22/03

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